

ESTTA Tracking number: **ESTTA747420**

Filing date: **05/19/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91227260
Party	Defendant de Rothsman, Wallace Mayer
Correspondence Address	DE ROTHSMAN, WALLACE MAYER Triple Thirteen Group Inc 2221 NE 164th St Ste 296 North Miami Beach, FL 33160-3703 info@triplethirteengroup.com;WALLACE@TR
Submission	Answer
Filer's Name	Wallace Mayer de Rothsman
Filer's e-mail	info@peermiums.com
Signature	/Wallace Mayer de Rothsman/
Date	05/19/2016
Attachments	Peermiums - Trademark Opposition _ Signed.pdf(502257 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No. 86754033

For the mark: PEERMIUMS

Opposition No. 91227260

.....X
The Travelers Indemnity Company.,

Opposer,
v.

TRIPLE THIRTEEN GROUP INC.

Applicant.

.....X

**APPLICANT’S MOTION FOR SUMMARY JUDGMENT ON OPPOSER’S
CLAIMS OF DILUTION AND LIKELIHOOD OF CONFUSION**

Pursuant to Fed. R. Civ. P. 56 and TBMP § 528, and for the reasons set forth in the attached Memorandum, applicant Triple Thirteen Group, Inc hereby moves for summary judgment on each of opposer The Traveler Indemnity Company’s claims in the Notice of Opposition to Application Serial No. 86754033 on the grounds that no reasonable trier of fact could find that Applicant’s mark is likely to dilute Opposer’s mark, and on the grounds that no reasonable trier of fact could find that Applicant’s mark is likely to cause confusion as to the source of Applicant’s and Opposer’s respective services.

Applicant’s Motion for Summary Judgment and Memorandum

Dated the 14th of May, 2016

Respectfully Submitted,
TRIPLE THIRTEEN GROUP, Inc
By:

Wallace Mayer de Rothsman

Wallace Mayer de Rothsman
2221 NE 164th St Suite 296
Aventura, FL 33160
(p) 877-677-2236
Applicant

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No. 86754033

For the mark: PEERMIUMS

Opposition No. 91227260

.....X
The Travelers Indemnity Company.,

Opposer,
v.

TRIPLE THIRTEEN GROUP INC.

Applicant.

.....X

**APPLICANT’S MEMORANDUM IN SUPPORT OF ITS MOTION FOR
SUMMARY JUDGMENT ON OPPOSER’S CLAIMS OF DILUTION AND
LIKELIHOOD OF CONFUSION**

I. INTRODUCTION

Peermiums, Inc (“Applicant”), a Delaware company, develops primarily modern information and Insurance software technology to connect users with insurance chatbots and algorithms, mainly, to execute a Virtual Assistant and Messenger Insurance Profile Phase . See Declaration of Wallace Mayer de Rothsman attached as “Exhibit A.” One of those software applications or

‘internet bots’, titled “PEERMIUMS,” is a matching based decision - making software application with Artificial Intelligence! Say anything you like or want in an insurance policy and it will reply. Moreover, It can remember multiple conversations between Insurers and Policyholders. It’s an Artificial Intelligence (AI) that learns from policyholder’s profile and aggregates policyholder’s comment feeds. Id. Applicant promotes its PEERMIUMS software applications “especially designed only for insurance agencies and insurance companies for the sole purpose of policy execution and insurance due diligence.” See Legal & General Group Plc use of the Umbrella logo attached as “Exhibit B.” On September 11th, 2015, Applicant filed an application for a federal registration of PEERMIUMS trademark for matching “Matching policyholders with premiums provided over a smartphone, wearables, and car networks.” Application Serial No. 86754033.

The Travelers Indemnity Company (“Opposer”), a Minnesota corporation, engages primarily in writing US commercial and US personal insurance through independent agents. In 1998, Opposer merged with Citicorp to form Citigroup. Citigroup spun off Travelers Property and Casualty into a subsidiary company in 2002. Id. In furtherance of its business operations, Opposer has not registered or never been assigned the Federal Trademarks of the red umbrella for software or insurance chatbots and algorithms and other software related services.

In April, 2016, Opposer filed a Notice of Opposition claiming that Opposer's marks are famous, Applicant's mark dilutes the fame of those marks, and Applicant's mark is likely to cause confusion with Opposer's common law rights and non-registered marks. *Id.* Applicant now files this Motion for Summary Judgment on both of Opposer's claims.

Summary judgment should be granted where the movant has shown there is no genuine issue of material fact and that is entitled to judgement as a matter of law. Fed. R. Civ. P. 56 (c); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 4 USPQ2d 1793, 1797 (Fed. Cir.1987). It is the movant's burden to demonstrate no issue of material fact and entitlement to judgment. *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986). The movant can meet that burden either by producing affirmative evidence supporting its case or by demonstrating an absence of evidence supporting the non-movant's case. *Id.*; *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986); *Copelands' Enterprises, Inc. v. CNV Inc.*, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991).

Opposer makes two claims in support of its allegations that registration of Applicant's mark would cause it damage: 1) Registration would dilute the distinctive quality of Opposer's RED UMBRELLA; and 2) Registration would be likely to cause confusion with Opposer's RED UMBRELLA logo. *Id.* However, as described above and below, Opposer has no statutory trademark rights to RED UMBRELLA logo for software purposes and chatbot or chat messenger. Moreover, Opposer has not provided evidence in supporting its claims and, regardless of the evidence, cannot prevail on those claims. Opposer's own evidence of the Red Umbrella logo demonstrates that its marks are not famous in the chatbot space. Opposer's own evidence demonstrates that, even assuming its marks were famous, registration of Applicant's

mark is not likely to dilute Opposer's marks. Opposer's own evidence shows that registration of Applicant's mark is not likely to lead to consumer confusion as to the source of Opposer's and Applicant's respective services.

Because Opposer cannot prevail on either of its claims, Applicant respectfully moves the Board to grant summary judgment to Applicant on Opposer's claim of dilution, to grant summary of judgment to Applicant on Opposer's claim of likelihood of confusion, and to dismiss the Opposition with prejudice.

II. NO REASONABLE TRIER OF FACT COULD FIND THAT APPLICANT'S MARK DILUTES OPPOSER'S MARKS

The undisputed evidence shows that Opposer's marks are not famous for Messenger and Insurance chatbot, and even if they are famous, Applicant's mark does not dilute Opposer's marks. No reasonable trier of fact could conclude that Applicant's mark dilutes Opposer's marks. None of the facts and evidence would prove or disprove Opposer's dilution claim are disputed,

and, as described below, Applicant is entitled to judgment as matter of law. Therefore, Applicant is entitled to summary judgment on Opposer's claim of dilution.

A. Statement of Undisputed Facts Material to Dilution

The following undisputed facts prove that Opposer's marks are not famous for Insurance Chatbot and Messenger, and that even assuming Opposer's marks are famous, Applicant's mark is not likely to dilute Opposer's marks:

1. Opposer, according to the documents it produced, has failed to prove that a vast number of consumers in the United States immediately associate Opposer with Insurance chatbots, Messenger Insurance software logo it claims is famous.
2. Opposer has failed to prove its annual ad spending on the marks it claims are famous for Chatbots and Insurance Messenger. Furthermore, Opposer has failed to prove relationship between its advertising expenditures and trademark value for Red Umbrella logo.
3. Opposer has failed to prove a mark-specific valuation approach or any less sophisticated valuation techniques that produce questionable values to the logo it claims is famous.
4. Opposer, during the time it claims its marks are famous, has failed to provide a direct link between its mark value and sales or commercial advertising revenues.
5. Opposer is not one of the top four Insurance Software firms in revenue. Id.

6. In the entire history of the Red Umbrella logo. It has not been mentioned in the media for Insurance Chatbot nor Messenger Software;

7. However, Red Umbrella logo; Green Umbrella logo, Gray Umbrella logo, Blue Umbrella logo have been mentioned in a vast number of TV ads based on providing auto insurance policy. They are: LEGAL & GENERAL GROUP PLC, FARMERS GROUP, AVIRA, TWINSURANCE, MJM INSURANCE SR22 INSURANCE, KARTOMA HOME INSURANCE, FLOOD INSURANCE SERVICES INC, THE MODERN INSURANCE STORE, and COVERED INSURANCE SOLUTIONS.

8. Applicant's mark PEERMIUMS is a software application powered by Artificial Intelligence, it's not made for writing commercial and personal insurance, it's not made for Underwriting, there are no adjusters, our audience is the global software application developers, our members are highly sophisticated software developers. Full Members have access to the member-only platform. Applicant's industry is not identical to Opposer's industry. Therefore, a reasonable buyer or viewer is not at all likely to link the two uses of the trademark in his or her own mind, even subtly or subliminally.

B. Trademark Dilution Standard

Trademark dilution is an “extraordinary remedy” available only to singularly famous marks so widely recognized that they are at risk of blurring or tarnishment even from non-competing marks. *Advantage Rent-A-Car Inc. v. Enterprise Rent-A-Car Co.*, 57 USPQ2d 1561, 1563 (5th Cir. 2001). To succeed in a claim dilution, an Opposer must prove its mark is famous and distinctive for dilution purposes. Lanham Act §43(c)(1). It’s clear that Opposer marks are not distinctive and famous for chatbot and insurance software and have never been registered. The entire nation was not on notice of Opposer’s claim, in other words, Opposer has no statutory trademark rights for Red Umbrella logo for Chatbots. Even assuming Opposer’s marks were famous, there’s no likelihood Applicant’s mark will blur or tarnish Opposer’s marks.

C. Opposer’s Marks Are Not Famous and Distinctive

The standard for fame and distinctiveness under dilution law is higher than the standard for fame for likelihood of confusion purposes. *7-Eleven, Inc. v. Lawrence I. Wechsler*, 83 USPQ2d 1715, 1721 (TTAB 2007). To be eligible for dilution protection, a mark owner must prove the mark is famous and distinctive to the “general consuming public.” 15 U.S.C. §1125(c)(2)(A). A mark is famous and distinctive for dilution purposes if “the mark has become the principal meaning of the word.” *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001) (“The mark owner must demonstrate that the common or proper noun

uses of the term and third party uses of the mark are now eclipsed by the owner's use of the mark"). To prevail on dilution, an Opposer must show that when the general public encounters the Opposer's mark, in almost any context, they associate it with the Opposer. *Id.*

1. Opposer's Failure to Prove The Value Relevance of Its Marks and The Calculated Intangible Value (CIV)

CIV examines earnings performance and identifies the assets that produced those earnings. Furthermore, merely showing that a mark is a top selling brand is not sufficient to show that it is famous. *Id.* at 1181. Instead, the law requires direct evidence of a transformation from a merely strong mark to a "truly famous" mark, such as recognition by the other party, intense media attention, or surveys showing widespread consumer recognition of the mark. *Id.* For instance, the TTAB found the TORO mark was not famous and distinctive for dilution purposes despite \$1.3 billion in annual sales, tens of millions of dollars in annual advertising, and recognition as a leader within its industry. *Id.* at 1170. Owners of marks that were found to be famous and distinctive for dilution purposes provided additional evidence of significance to the general public. See *NASDAQ Stock Market, Inc. v. Antartica, S.R.L.*, 69 USPQ2d 1718 (TTAB 2003) (where NASDAQ presented evidence of "countless" references to its mark in third party publications, as well as, survey data showing video recognition even to non-investors).

In the present case, Opposer has failed to provide any evidence that would allow a reasonable fact finder to conclude that the RED UMBRELLA logo marks are famous and distinctive for Chatbot and Insurance Messenger.

Opposer has not established wide recognition as a leader in the ChatBot and Insurance Messenger space. Indeed, Opposer's own evidence demonstrates that it is far from a leader in "Artificial Intelligence " and Insurance Messenger market. Opposer's brand is no more than a small player in the venture capital industry, and is clearly not a famous brand in that space.

2. Opposer's Marks Lack Widespread Third-Party Recognition and Therefore Are Not Famous

Opposer has not provided, and cannot provide, evidence of the quantum and quality necessary to establish that Red Umbrella marks are "truly famous" for Chatbot and Insurance Messenger marks. Opposer has not provided evidence of widespread third party media recognition or any other evidence of the intense media attention to show that Opposer's Red Umbrella brands are famous for Chatbot and Insurance Messenger marks. Moreover, Opposer has produced no other evidence of third party media recognition and has not conducted any surveys demonstrating the public's perception of the RED UMBRELLA logo. Without this evidence, of the type and quality demanded by the Board in Toro, 7-Eleven, and NASDAQ, no reasonable finder of fact could conclude that Opposer's Red Umbrella logos are famous and distinctive for ChatBots and Algorithms. Consequently, Opposer's claim of dilution should be dismissed on summary judgment.

D. Conclusion

Opposer has not produced evidence sufficient to create an issue of material fact on its claim of dilution. Applicant's industry is not substantially similar to Opposer's industry. For those reasons, Applicant respectfully requests that the Board enter summary judgment in its favor on Opposer's claim of dilution and dismiss the claim with prejudice.

III. NO REASONABLE TRIER OF FACT COULD FIND A LIKELIHOOD OF CONFUSION AS BETWEEN APPLICANT'S MARK AND OPPOSER'S MARKS

Opposer has presented little or no evidence to support its claim that registration of Applicant's mark will cause confusion with Opposer's marks. The undisputed evidence demonstrates that the services are different, the industries are different, Opposer's marks are not famous in Artificial Intelligence and Messenger for Insurance, and no other likelihood of confusion factor outweighs the clear differences between the respective services represented by Opposer's marks. There are no facts in dispute relevant to the presence or absence of a likelihood

of confusion between the marks, and, as described below, Applicant is entitled to summary judgment on Opposer's claim of likelihood of confusion.

A. Statement of Undisputed Facts Material to Likelihood of Confusion

The following undisputed facts prove that registration of Applicant's mark is not likely to cause consumer confusion as to the relative source of Applicant's and Opposer's respective services:

1. Applicant's services are "Artificial Intelligence and Messenger provided over a compute, smartphone, wearables, and car network." Application Serial No. 86754033.
2. Opposer's services are not Artificial Intelligence and Messenger provided over a compute, smartphone, wearables, and car network." Moreover, Opposer's services are not a Chatbot decision making software - making software application with Artificial Intelligence.
3. Numerous third parties use the Umbrella logo to identify themselves as a source for writing personal and commercial insurance claims to sell exclusively
<http://www.legalandgeneral.com>

-
4. Opposer has never used RED UMBRELLA LOGO or a variant thereof on Artificial Intelligence provided over a computer network and matching based decision - making software application with Actual Intelligence. Id.
 5. Opposer has no evidence of actual confusion with Applicant's mark.

**B. Applicant's Mark is Not Likely To Cause Confusion As To The
Source Of Applicant's And Opposer's Respective Services**

Even in the light of most favorable to Opposer, no reasonable trier of fact could conclude that Applicant's U Umbrella logo which is an Artificial Intelligence service is likely to cause confusion with Opposer's Red Umbrella logo. The test of likelihood of confusion at the Board is the DuPont test. In re E.I. DuPont DeNemours & Co. , 476 F. 2d 1357, 1361 (CCPA 1973). While all twelve factors of the DuPont test may be considered in any one instance, one or a small number of factors may be determinative. See generally In re Majestic Distilling Co. , 315 F.3d 1311, 1315 (Fed. Cir. 2003); In re Dixie Rests., 105 F. 3d 1405, 1406 (Fed. Cir. 1997); Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc., 889 F.2d 1070, 1073 (Fed. Cir.1989).

In this case, there are significant differences between Applicant's industry and Opposer's industry, and between Applicant's services and Opposer's services. Under the DuPont standard, the differences in the marks presented, the differences in the industries, the differences in the services, the weakness of the AND and OWN IT components of Opposer's marks, and Opposer's lack of any evidence on any other factor proves that Applicant is entitled to judgment as a matter of law and therefore summary judgment in favor of Applicant is appropriate.

1. The Services Are Not Similar

Evaluation of the differences in the goods requires a determination of whether the services are sufficiently related in a commercial sense that consumers would be likely to attribute them to the same source. *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991).

Applicant's U Umbrella logo application is for Chatbot and Insurance Messenger provided over a computer, smartphone, and car network and matching based decision - making software application with Actual Intelligence. Application Serial No. 86754033. Opposer has not registered Umbrella logo but use it for significantly different services.

Consumers would not be led to believe one source produced both services. None of Opposer's services are Artificial Intelligence and Messenger service provided over a computer network and matching based decision - making software application with Actual Intelligence. *Id.* Furthermore, Opposer has no evidence of any instances of actual confusion between the marks of the parties. Therefore, it's not likely consumers would think the services emanate from the source because Opposer does not create software applications and Opposer is not an online platform or any services related to Artificial Intelligence and Insurance Chatbot provided over a computer, smartphone, and car network.

IV. CONCLUSION

The goal of summary judgment is to “test the sufficiency of the evidence,” and quickly decide cases in which one side has made claims and then failed to present evidence to support those claims. See e.g., *Dyneer Corp. v. Automotive Products pl*, 37 USPQ 1251, 1254 (TTAB 1995). Such a decision is appropriate here. Opposer has made a number of claims, including that it is a famous mark, a mark that is, familiar to a vast number of consumers in the United States who immediately associate the phrase with opposer. But yet, Opposer has never registered the mark, and opposer has absolutely no statutory rights to the mark. Moreover, In spite of the grand claims in its Opposition, Opposer has failed to produce any evidence of fame, dilution, or likelihood of confusion. Given the significant differences between the parties’ industry and services, Opposer has not created a triable issue of fact on its claims of dilution and likelihood of confusion. Wherefore, Applicant respectfully requests that the Board enter summary judgment dismissing each of Opposer’s claims, and dismissing the Opposition with prejudice.

Dated the 14th of May, 2016

Respectfully Submitted,

TRIPLE THIRTEEN GROUP, INC

By:

Wallace Mayer de Rothsman

Wallace Mayer de Rothsman
2221 NE 164th St Suite 296
Aventura, FL 33160
(p) 877-677-2236
Applicant

CERTIFICATE OF SERVICE

I hereby certify that true copies of the Applicant's Motion for Summary Judgment on Opposer's Claims of Dilution and Likelihood of Confusion were deposited as First Class mail with UPS on May 16th, 2016 to Counsel for Opposer at the following address:

David M. Kelly

Kelly IP, LLP

1919 M Street, N.W.Suite 610

WASHINGTON, DC 20036

By:

Wallace Mayer de Rothsman

Wallace Mayer de Rothsman

EXHIBIT A

DECLARATION OF WALLACE MAYER de ROTHSMAN

This supplementary affidavit is filed in connection with Triple Thirteen Group, Inc's MEMORANDUM IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT ON OPPOSER'S CLAIMS OF DILUTION AND LIKELIHOOD OF CONFUSION in regard to Application Serial No. 86754033.

My name is Wallace Mayer de Rothsman. I am a resident of Aventura, FL. I am over the age of eighteen, and have actual personal knowledge of the facts stated herein. The following statements are true and correct to the best of my knowledge:

I'm currently the Chairman and Founder of Peermiums, Inc ("PEERMIUMS"). Peermiums's principal office is located in Aventura, Florida.

Peermiums is a Virtual Assistant powered A.I software application for Insurance due diligence and premiums generator and a matching based decision making internet bots for all sort of Insurance services. I started working on this project since 2009.

Wallace Mayer de Rothsman

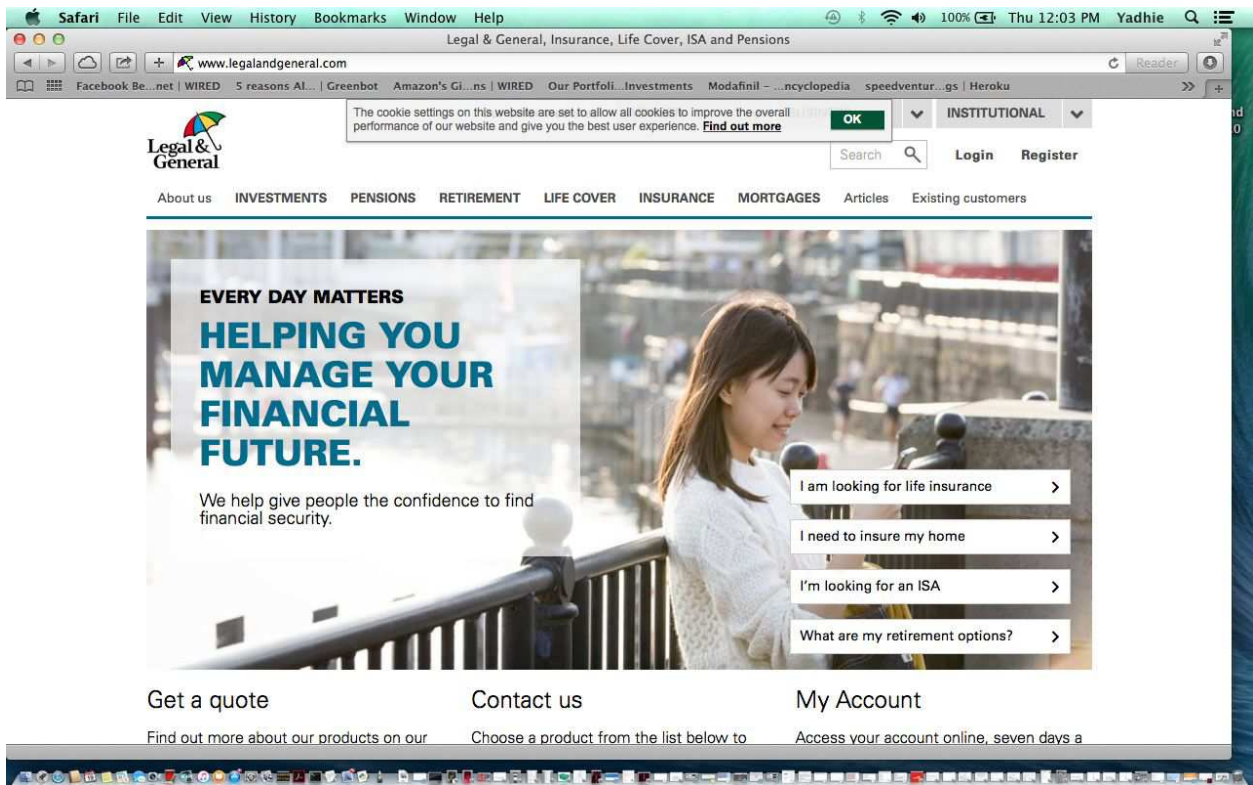
Signature

Wallace Mayer de Rothsman
Name

05/14/2016
Date

Applicant's Motion for Summary Judgment and Memorandum

EXHIBIT B



Source: <http://www.legalandgeneral.com>

